

# Notice of Allowability

Application No.

09/839,049

Examiner

William K Cheung

Applicant(s)

CRAUN ET AL.

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--  
All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS. This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to IDS (Paper No. 3).
2. ☒ The allowed claim(s) is/are 1-31.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the top margin (not the back) of each sheet. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

- |  |   |
|--|---|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)          |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 4 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____             |
| 5 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. 3.       | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                  |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
|  | 9 <input type="checkbox"/> Other  |

**DETAILED ACTION**

***Restriction / Election***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 to 31, drawn to a coating composition, classified in class 524, subclass 284.
  - II. Claims 32-47, drawn to a polymerization process, classified in class 524, subclass 352.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make other and materially different product such as non-ambient paint coating composition.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Brian M. Kolkowski (Registration 36,847), on September 23, 2002, a provisional election was made with traverse to prosecute the invention of Group I, claims 1 to 31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### **EXAMINER'S AMENDMENT**

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Eileen T. Mathews (Registration No. 41,973) on October 30, 2002.

7. Claim 12 (line 2), replace "hydracrylic" with "hydroacrylic".
8. Cancel non-elected claims 32-47.

#### ***Allowances***

9. Claims 1-31 are allowed.
10. The following is an examiner's statement of reasons for allowance:

As of the date of this office action, the examiner has not located or identified any reference that can be used singularly or in combination with another reference including the closest prior art of Ohara et al. (US 5,880,254) and Floyd et al. (US 5,326,808) to render the present invention anticipated or obvious to one of ordinary skill in the art.

***The invention of claims 1-31 relates to an ambient paint coating composition substantially free of volatile coalescing solvent, the paint having a film forming polymeric binder comprising by weight: an aqueous emulsion polymeric film forming matrix polymer of copolymerized ethylenically unsaturated monomers; and at least 3%***

***of a low molecular weight poly(hydroxyl alkanoic acid) oligomer of copolymerized hydroxy alkanoic acid having from 2 to 4 carbon atoms and being an external modifier of the matrix polymer, the oligomer having number average molecular weight between about 300 and 10,000 and a  $T_g$  below 0°C, the oligomer having terminal alkyl aliphatic ester groups where the alkyl chain has from 3 to 20 carbon atoms, where the mixture of the oligomer and the matrix polymer are film forming and provide an air dry coating composition substantially free of organic coalescing solvent.***

The closest prior art Ohara et al. (abstract) teach a poly(alkanoic acid) or poly(lactic acid) having a weight average molecular weight of 1000 or less which overlaps with applicants' claimed molecular weight can be made. Since the molecular weight properties of the poly(lactic acid) as disclosed in Ohara et al. is substantially identical to the poly(alkanoic acid) as claimed, the examiner has a reasonable basis to believe that the claimed glass transition temperature of below 0 °C is inherently possessed by the disclosure to Ohara et al. However, Ohara et al. are silent on an ambient paint coating composition containing poly(alkanoic acid) and is substantially free of volatile coalescing solvent. Therefore, it would not be apparent to one of ordinary skill in the art to use the polylactic acid teachings in Ohara et al. to obtain applicants' ambient paint coating invention of claims 1-31.

Floyd et al. (abstract) disclose an aqueous ambient dry paint coating based on vinyl acetate matrix polymer containing an oligomer selected from a polyurethane or a polyester having a  $T_g$  below  $-20^\circ\text{C}$  and a number average molecular weight between 200 and 20,000. However, Floyd et al. are silent on an ambient coating composition containing a poly(alkanoic acid) because Floyd et al. are clearly silent on a homopolymer or copolymer containing an aliphatic hydroxy carboxylic acid. According to applicants' specification (page 5, 3<sup>rd</sup> paragraph), a poly(alkanolic acid) oligomer and poly(hydroxy acid) oligomer are equivalent terms and are homopolymers or copolymers of aliphatic hydroxy carboxylic acid having from 2 to 4 carbon atoms. Therefore, it would not be apparent to one of ordinary skill in the art to use the ambient dry paint coating teachings of Floyd et al. to obtain applicants' invention of claims 1-31 which relates to an ambient paint coating composition containing a poly(alkanoic acid) oligomer.

In view of the reasons set forth above, the invention of claims 1-31 is allowed.

### **Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (703) 305-0392. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5885 for regular communications and (703) 305-5885 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



William K. Cheung  
October 31, 2002



DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700